

Appl. No. 10/823,829
Amdt. dated December 15, 2004
Reply to Office action of August 19, 2004

ARGUMENTS

Claims 1-13 are pending in the application, and claims 1-13 have been rejected. Paragraphs 16 and 24 of the specification, as well as claims 1, 3, 5, 7, 9 and 11 have been amended, and new claims 14-16 have been added. No new matter has been added.

The amendments made to the specification are proper and find support in the specification. As defined in amended paragraph 16, a "competency" is a cluster of capabilities that have been honed and developed into a level of expertise. Included in this cluster of capabilities are those described in paragraph 24, i.e., Integrity, Continuous Learning, Speed/Initiative, Energized Team-building, Quality/Customer Oriented, Extraordinary Results, Effective Communication, Financial Literacy, Strategic Focus, and Emotional Maturity. Paragraph 32 of Applicants' specification explains how high performers with a proven track-record expertise are administered a battery to statistically determine competency accuracy. It can therefore be inferred that a competency is indicative of a level of expertise.

Amended paragraph 24 defines "attributes" as personal qualities that influence competency and, as such, may be used to measure one's capability to accomplish behavior in a competency. As an example, paragraph 27 of Applicants' specification identifies the attributes of Assertiveness, Creativity, Strategy, Motivation and Innovation as personal qualities that influence the competency of Strategic Focus.

Responsive to the rejection of claims 1-4 under 35 U.S.C. § 101 as being directed to non-statutory subject matter for not being limited to the technological arts, Applicants submit that the proposition for which Examiner cites *In re Toma*, 197 U.S.P.Q. 852 (CCPA 1978) and *Ex parte Bowman*, 61 U.S.P.Q. 2d 119 (Bd. Pat. App. & Int. 2001) is not inconsistent with claims 1-4 of Applicants' application for patent being patentable subject matter. Examiner cites *Toma* and *Bowman* for the proposition that under 35 U.S.C. § 101, an invention must be limited to the technological arts in addition to producing a useful, concrete and tangible result.

Appl. No. 10/823,829
Amdt. dated December 15, 2004
Reply to Office action of August 19, 2004

The *Toma* board indicated that the "technological" or "useful" arts inquiry must focus on whether the claimed subject matter is statutory. 197 U.S.P.Q. 857. In discussing statutory subject matter, the board in *Bowman* emphasized that despite the express language of 35 U.S.C. § 101, laws of nature, natural phenomena and abstract ideas have been excluded from Section 101 statutory subject matter. 61 U.S.P.Q. 2d 1671. In accordance with the statutory language, the board confirmed the examiner's finding that the claimed invention was an abstract idea that did not fall within the technological arts because the applicant had not tied the disclosed and claimed invention to any technological art or environment by failing to recite the use of a computer in either the specification or the claims. *See id.*

Toma and *Bowman* can be distinguished from the present case because Applicants recited the use of a computer throughout the specification in regards to the subject matter claimed in amended claims 1-4. Regarding amended claim 1, paragraph 23 of Applicants' specification discloses that a computer may be used to carry out the providing of a plurality of capability tests and the obtaining responses method steps of amended claim 1 (i.e., "[a]dministering instruments by a computer program, particularly a computer program accessed over a telecommunications network such as the Internet, makes the administration and collection of response data particularly efficient"). Indeed, as described in paragraph 25 of Applicants' specification, in an "exemplary embodiment" of Applicants' invention, the plurality of capability tests ("battery" in the specification) is administered by sending a personally addressed e-mail to the respondent describing the assessment process, providing instructions for taking the instruments and inserting a secure, coded hyperlink direct to the respondent's personal battery. The respondent may use the hyperlink to activate the web pages containing the battery, and the respondent interacts with the web pages to provide responses to the several questions of the battery. (Applicants' specification, paragraph 25). Paragraph 22 discloses that a computer may be used to carry out the cross-referencing method step of amended claim 1 (i.e., "a computer may proceed with cross-referencing step 30 which cross-references the responses to the several questions administered in testing step 10...").

Appl. No. 10/823,829
Amdt. dated December 15, 2004
Reply to Office action of August 19, 2004

Therefore, because Applicants' specification discloses the use of computers to carry out the method steps of amended claim 1, Applicants submit that the claimed subject matter of claim 1 is tied to the technological arts and meets the technological arts requirement of 35 U.S.C. § 101. Because claims 2-4 depend from amended claim 1, Applicants submit that the subject matter of these claims meet the technological arts requirement as well.

Responsive to the rejection of claims 1-13 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application 2002/0045154 to Wood et al. ("Wood"), Applicants submit that Wood does not teach every recitation of amended claims 1, 5 and 9.

Each of amended claims 1, 5 and 9 recite the provision of a plurality of individual capability tests to rate a plurality of competencies of an individual, the individual capability tests each having a plurality of questions used to assess a plurality of *attributes* associated with at least one of the plurality of competencies.

Wood teaches a system that utilizes one or more instruments to measure the system user's characteristics in order to classify the person into a selected personality scheme and to match advice, content and other people with the user based upon the results of the instruments. (Paragraph 45). The instruments provide questions to the user to obtain different types of data, including demographic data, psychographic data, personality data (including data that measures cognitive skills and competencies), life style and quality of life data, application specific data, behavioral data, declared preferences data, scenario based testing data and roll play based testing data. (Paragraphs 75 – 168). The obtained data is then scored, standardized into alphanumeric representations and compared to personality models so that the user can be classified into a personality scheme. (Paragraph 81).

While the personality instruments taught by Wood may be used to obtain data that measures one's skills and competencies, Wood does not disclose, teach or suggest that the instruments may be used to assess a plurality of *attributes* associated with at least one of a

Appl. No. 10/823,829
Amdt. dated December 15, 2004
Reply to Office action of August 19, 2004

plurality of competencies. As defined in paragraph 24 of the amended specification, "attributes" are personal qualities that influence a competency, and attributes may be used to measure one's *capability to accomplish behavior in a competency*. The data obtained by the Wood system, however, is used only to measure a person's skill level and competencies and not a person's capability to accomplish behavior in a competency. Wood describes the following example in paragraph 350:

The system can be used to find/match people based upon a selection of personality traits, skills, competencies, attitudes, beliefs, behaviors, psychographic, demographic and resume items. An employer may wish to search a database based upon personality type or specific characteristics to find people that are best suited for a particular job. The system could be used to find people with particular skills or competencies or other characteristics that are best suited for a job.

As described in this paragraph, Wood teaches that the data obtained and assessed by the Wood system is used to measure one's skills and competencies as those skills and competencies are suited for a job and not to measure one's capability to accomplish a behavior in those competencies.

Amended claims 1, 5 and 9 also recite one of a step, a means for and a computer-implemented step of cross-referencing the responses to the plurality of questions of *at least two* of the plurality of individual capability tests to create a comprehensive individual capability evaluation that rates the plurality of competencies. Wood teaches that more than one instrument may be used to collect data (Wood, paragraph 191), and that the collected data is standardized and compared to a classification scheme (Wood, paragraph 192), but Wood does not disclose, teach or suggest that the responses from *at least two* of a plurality of instruments are used to create a comprehensive individual capability evaluation that rates the plurality of competencies.

Appl. No. 10/823,829
Amdt. dated December 15, 2004
Reply to Office action of August 19, 2004

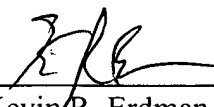
Because amended claims 1, 5 and 9 each include recitations not disclosed, taught or suggested by Wood, Applicants submit that Wood does not anticipate these claims. Further, dependent claims 2-4, 6-8 and 10-13 either directly or indirectly depend from one of amended claims 1, 5 and 9 and incorporate the above-identified recitations. Thus, none of these dependent claims are anticipated by Wood.

For all of the above reasons, Applicants submit that claims 1-4 meet the technological arts requirement and that claims 1-13 are not anticipated by Woods, thereby placing the application in condition for allowance. Applicants believe that new claims 14-16 are in condition for allowance as well. Applicants respectfully request allowance thereof.

Should any questions concerning any of the foregoing arise, Examiner is invited to telephone the undersigned at (317) 237-0300.

In the event that Applicants have overlooked the need for an extension of time or a payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,



Kevin R. Erdman, Reg. No. 33,687
Attorney for Applicants